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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,305	02/06/2002	Johann Oberhofer	70301/56912	9847

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EXAMINER

TENTONI, LEO B

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,305

Applicant(s)

OBERHOFER ET AL.

Examiner

Leo B. Tentoni

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-99 is/are pending in the application.
- 4a) Of the above claim(s) 58,59,71,82-84,86 and 89-98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-57,60,64-70,72-75,78-81,85,87,88 and 99 is/are rejected.
- 7) ☒ Claim(s) 61-63, 76 and 77 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The objection to the abstract, the objection to the disclosure and the rejection of the claims under 35 USC § 103(a) over the patents to Dickens, Jr. et al and Russell et al set forth in the previous Office Action (mailed on 28 May 2004) are withdrawn.

Election/Restrictions

2. Claims 58, 59, 71, 82-84, 86 and 89-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 06 May 2004.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant

is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 44, 45, 48-57, 60, 64-66, 69, 70, 72-75, 80, 81, 85, 87, 88 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al (U.S. Patent 5,846,370) in combination with Caldarise (U.S. Patent 5,662,158) for the reasons of record set forth in the previous Office Action (mailed on 28 May 2004).

6. Claims 46, 47 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor (U.S. Patent 5,846,370) in combination with Caldarise (U.S. Patent 5,662,158) as applied to claims 44, 45, 48-57, 60, 64-66, 69, 70, 72-75, 80, 81, 85, 87, 88 and 99 above, and further in view of Newell et al (U.S. Patent 5,932,055) for the reasons of record set forth in the previous Office Action (mailed on 28 May 2004).

7. Claims 67, 68 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor (U.S. Patent 5,846,370) in combination with Caldarise (U.S. Patent 5,662,158) as applied to claims 44, 45, 48-57, 60, 64-66, 69, 70, 72-75, 80, 81, 85, 87, 88 and 99 above, and further in view of Grube et al (WO 92/08592) for the reasons of record set forth in the previous Office Action (mailed on 28 May 2004).

Allowable Subject Matter

8. Claims 61-63, 76 and 77 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed on 30 August 2004 have been fully considered but they are not persuasive.

Applicant argues (pages 14 and 15) that the invention is directed to controllably removing and controlled removal of non-solidified powder material, and provides the meaning of (or defines) ``controllably removing'' and ``controlled removal'' . Examiner responds that the originally-filed specification does not explicitly provide these meanings and it is not clear what the basis is for these meanings. Furthermore, the originally-filed specification does not appear to be as limiting (with respect to these terms) as the meanings (or definitions) argued by applicant.

Applicant argues (page 15) that Caldarise fails to suggest or teach controllably removing or controlled removal of non-solidified powder material and that Caldarise teaches shaking or immersing in a bath or solvent, which are usually performed manually. Examiner responds that Caldarise is not limited to manual techniques as Caldarise teaches subjecting a casting mold (which is formed, and contains non-solidified powder material) to

ultrasonic or high frequency vibration. Examiner submits that Caldarise teaches controllably removing and controlled removal of non-solidified powder material within the meaning set forth in the originally-filed specification, including the use of a fluid.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo B. Tentoni whose telephone number is (571) 272-1209. The examiner can normally be reached on Monday - Friday (6:30 A.M. - 3:00 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni can

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be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leo B. Tentoni

Leo B. Tentoni
Primary Examiner
Art Unit 1732

lbt